Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLINTON S. SHEPPARD and DONALD R. MCCOMBES

Appeal No. 2001-0678
Application No. 08/877,711

ON BRIEF

Before KRASS, BARRETT and SAADAT, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request that we reconsider that part of our decision of January 17, 2003 wherein we sustained the examiner's rejection of claims 1-4, 10-29 and 31 under 35 U.S.C. 103. Presumably, appellants do not request reconsideration of our decision to reverse the examiner's rejection of claims 5-8, 30 and 32-42 under 35 U.S.C. 103.

In particular, appellants do not contend that our broad interpretation of the instant claim language is erroneous. Rather, appellants request that we permit amendments to be made to the independent claims in order to clarify that the "operator" and the "person" are not the same individual.

We decline the invitation to order the examiner to permit this amendment at this time because while such an amendment would appear to distinguish the instant claims over our specific reasoning in sustaining the rejection of the claims, the requested amendment might, conceivably, raise new issues. We would prefer that any such amendment be presented to the examiner for review, either through a request for amendment after decision on appeal or through refiling the application. In this way, the examiner can make a thorough review of such amended claims, having our decision as a guide, and can make the determination as to whether a new search of the prior art may be necessary and/or whether there is some new rationale which might be applied against such newly amended claims.

While we regret the delay attendant in such a review by the examiner, especially in view of the already extended prosecution, it is our view that this procedure would result in a much more thorough consideration of any new issues presented by the newly

amended claims and, if the case is eventually passed to issue, a stronger patent will result. If, after full and deliberate consideration, the examiner agrees that the amendment does, indeed, place the claims in condition for allowance, the examiner can readily allow the claims. On the other hand, if the examiner decides otherwise, and the case returns to this Board on appeal, we will have a complete record, with the full reasoning of both appellants and the examiner before us, and a more reasoned decision can be made based on such reasoning.

Appellants also request that if we should decline the admission of the proposed amendment, then "further clarification concerning the motivation needed to justify the suggested modifications or combinations of references necessary to maintain the rejections" [Request for Rehearing-page 2] is sought.

Since, in our view, we provided sufficient "motivation needed to justify the suggested modifications" in our decision, it is not clear to us what "further clarification" appellants seek. For example, the rejection of claim 1 was sustained based on Sharrard, alone, after concluding that the claim did not preclude the operator and the person from being the same individual. Accordingly, no modification of the reference, or motivation to combine, was necessary. For other claims, e.g.,

the "strip tease act" of claim 3, the "motivation" given was our view that it would have been obvious to apply the Sharrard teachings to many activities where age appropriateness is an issue, whether it be for admission to movies or strip-tease acts or for permission to purchase alcohol, tobacco or firearms, etc.

Appellants specifically point only to page 7, lines 3-17, of our decision as an example of our failure to justify modifications or motivation. However, reference to that portion of our decision is very explicit as to how alarms and warning devices were well known and why it would have been obvious to incorporate such a device in the system of Sharrard. In addition, we explained that it would also be reasonable to find that the simple diversion of the coins themselves in Sharrard constitutes a "warning device" since it indicates to the operator that the operator is underage. Accordingly, we find unpersuasive appellants' allegation that our decision "lacked any discussion of the motivation or suggestions justifying the necessary combination of references needed to reach claim 15" [Request for Rehearing-page 3].

Appellants' request for rehearing has been granted to the extent that we have reconsidered our decision of January 17, 2003

but it is denied with respect to making any changes therein and/or entering any claim amendment.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

ERROL A. KRASS Administrative Patent Judge	)	
LEE E. BARRETT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MAHSHID D. SAADAT Administrative Patent Judge	)	

EK/RWK

R DARRYL BURKE
MCKOOL SMITH, P.C.
300 CRESCENT COURT, SUITE 1500
DALLAS, TX 75201